

REMARKS

Claims 24-42 are pending in the present application. By virtue of this response, claims 27-28, 31-32 and 38 have been amended for antecedent basis and to correct an inadvertent word processing error. Claims 41-42 have been cancelled, without prejudice. Accordingly, claims 24-40 are currently under consideration. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented. Applicants reserve the right to prosecute the subject matter of cancelled claims in a related application.

Rejection of claims under 35 U.S.C. 112, first paragraph

Claims 41-42 stand rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement.

Applicants traverse this rejection of claims 41-42. Applicants believe claims 41-42 do not involve new matter. Applicants submit that the specification at the paragraph bridging pages 7-8 describes that the foreign gene construct is cloned into a nucleotide sequence which represents only a part of the entire viral genome having one or more appropriate deletions. Without conceding as to the correctness of the Examiner's rejection and solely in an effort to expedite prosecution, Applicants have canceled claims 41-42 thereby obviating the Examiner's rejection. Applicants request withdrawal of this rejection of claims.

Double Patenting

A. Claims 24-40 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4-7, and 9-12 of U.S. Patent No. 6,001,591.

The Examiner rejects instant claims 24-40 under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1, 4-7, and 9-12 of U.S. Patent No. 6,001,591. The Examiner alleges that although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to bovine

adenovirus vectors with a deletion/insertion in the E1 region. Applicants invite the Examiner's attention to claims 5, 8 and 11 of U.S. Patent No. 6,001,591. Claims 5, 8, and 11 are ultimately dependent upon claim 2 which recites, in part, a live recombinant BAV expression vector comprising a BAV genome with a deletion of all or part of the E3 region. Thus, the Examiner is incorrect in the characterization of claims 5, 8 and 11. Applicants request clarification from the Examiner as to the claims rejected under the judicially created doctrine of obviousness-type double patenting. Without acquiescence to the rejection and in the interest of expediting prosecution, Applicants note their willingness to file a Terminal Disclaimer over U.S. Pat. No. 6,001,591 upon notification of otherwise allowable subject matter in the present application.

B. Claims 24-40 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4, 6, 7, 9-21, 23, 24, and 26 of U.S. 6,086,890.

In response, without acquiescence to the rejection and in the interest of expediting prosecution, Applicants note their willingness to file a Terminal Disclaimer over U.S. Pat. No. 6,086,890 upon notification of otherwise allowable subject matter in the present application.

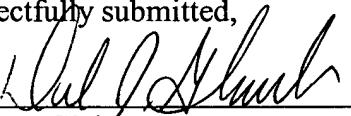
CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 293102002103. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: September 22, 2004

Respectfully submitted,

By 
Debra J. Glaister

Registration No.: 33,888
MORRISON & FOERSTER LLP
755 Page Mill Road
Palo Alto, California 94304
(650) 813-5725